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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/939,185	09/29/1997	JEAN M. GOLDSCHMIDT IKI	042390.P4500	3633

7590 12/18/2003

LAWRENCE M CHO
BLAKELY SOKOLOFF TAYLOR & ZAFMAN
12400 WILSHIRE BOULEVARD
7TH FLOOR
LOS ANGELES, CA 90025

EXAMINER

NGUYEN, CAO H

ART UNIT	PAPER NUMBER
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2173

DATE MAILED: 12/18/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
08/939,185

Applicant(s)
Goldschmidt Iki et al.

Examiner
Cao (Kevin) Nguyen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on RCE filed on 10/09/03.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 91 and 92 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 91 and 92 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

Request for Continued Examination (RCE)

1. The request filed on 10/09/03 for a Request for Continued Examination (RCE) under 37 CFR 1.53(d) based on parent Application No. 08/939,185 is acceptable and a RCE has been established. An action on the RCE follows.

706.03(w) Res Judicata

Res judicata may constitute a proper ground for rejection. However, as noted below, the Court of Customs and Patent Appeals has materially restricted the use of res judicata rejections. It should be applied only when the earlier decision was a decision of the Board of Appeals or any one of the reviewing courts and when there is no opportunity for further court review of the earlier decision. The timely filing of a second application copending with an earlier application does not preclude the use of res judicata as a ground of rejection for the second application claims. When making a rejection on res judicata, action should ordinarily be made also on the basis of prior art, especially in continuing applications. In most situations the same prior art which was relied upon in the earlier decision would again be applicable. In the following cases a rejection of a claim on the ground of res judicata was sustained where it was based on a prior adjudication, against the inventor on the same claim, a patentably nondistinct claim, or a claim involving the same issue.

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In re Freeman, 30 F.3d 1459, 31 USPQ 2d 1444 (Fed. Cir. 1994). Edgerton v. Kingland , 168 F. 2d 121, 75 USPQ 307 (D.C. Cir. 1947).

In re Szwarc , 319 F.2d 277, 138 USPQ 208 (CCPA 1963).

In re Katz , 467 F.2d 939, 167 USPQ 487 (CCPA 1970) (prior decision by District Court). In the following cases for various reasons, res judicata rejections were reversed.

In re Fried , 312 F.2d 930, 136 USPQ 429 (CCPA 1963) (differences in claims).

In re Szwarc , 319 F.2d 277, 138 USPQ 208 (CCPA 1963) (differences in claim).

In re Hellbaum , 371 F.2d 1022, 152 USPQ 571 (CCPA 1967) (differences in claims).

In re Herr , 377 F.2d 610, 153 USPQ 548 (CCPA 1967) (same claims, new evidence, prior decision by CCPA).

In re Kaghan , 387 F.2d 398, 156 USPQ 130 (CCPA 1967) (prior decision by Board of Appeals, final rejection on prior art withdrawn by examiner "to simplify the issue," differences in claims; holding of waiver based on language in MPEP at the time).

In re Craig , 411 F.2d 1333, 162 USPQ 157 (CCPA 1969) (Board of Appeals held second set of claims patentable over prior art).

In re Fisher , 427 F.2d 833, 166 USPQ 18 (CCPA 1970) (difference in claims).

In re Russell , 439 F.2d 1228, 169 USPQ 426 (CCPA 1971) (new evidence, rejection on prior art reversed by court).

In re Ackermann , 444 F.2d 1172, 170 USPQ 340 (CCPA 1971) (prior decision by Board of Appeals, new evidence, rejection on prior art reversed by court).

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Plastic Contact Lens Co. v. Gottschalk , 484 F.2d 837, 179 USPQ 262 (D.C. Cir.

1973) (follows In re Kaghan).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 91-92 are rejected under 35 U.S.C. 102(e) as being anticipated by Lopresti et al. (US Patent No. 5,889,506).

Regarding claim 43, Lopresti discloses a method for managing television program information in an entertainment system comprising: receiving broadcast television programming from a broadcast source [..the control unit is incorporated into any of the audio/video components including the television itself.; see col. 4, lines 22-44 and figure 2]; presenting a television programming guide to a user, data to support the television programming guide being stored in a location local to the entertainment system [..home entertainment systems the display function is provided by the TV and a TV tuner to supply the necessary audio and video signals to the VCR.; see col. 5, lines 8-64]; presenting a multimedia identifier to the user within the

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television programming guide, the multimedia identifier being associated with data about a particular television program [..The audio/video control may include a television tuner to supply the necessary audio and video signals to the VCR.; see col. 5, lines 30-37 and figure 4]; determining a location of the television program data corresponding to the multimedia identifier upon the multimedia identifier being selected by the user the command bar provides access to various functions.; see col. 7, lines 35-67]; retrieving the television program data corresponding to the selected multimedia identifier from a location remote from the storage location of the television programming guide and separate from the broadcast source [..the TV schedule and the VCR schedule are maintained as separate data structures, so that the user may program the TV and VCR independently.; see col. 10, lines 6-21]; and presenting the television program data to the user at the entertainment system within the television programming guide [..the TV schedule is an active schedule capable of highlighting which are current programs, updating the display in real time.; see col. 9, lines 10-61].

Regarding claim 92, Lopresti discloses wherein retrieving the television program data comprises retrieving the television program data from a remote web server [the shopping button could call up a web site on the Internet that could be used as a starting point for supplying hypertext links to other shopping locations.; see col. 10, lines 44-67].

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Conclusion

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. (PTO-892).

Response

5. Responses to this action should be mailed to Commissioner of Patents and Trademarks, Washington, D.C. 20231. If applicant desires to fax a response, (703) 308-9051 may be used for formal communications or (703) 305-9724 for informal or draft communications.

Please label "PROPOSED" or "DRAFT" for informal facsimile communications. For after final responses, please label "AFTER FINAL" or "EXPEDITED PROCEDURE" on the document.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA. Sixth Floor (Receptionist).


Inquires

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cao (Kevin) Nguyen whose telephone number is (703) 305-3972. The examiner can normally be reached on Monday-Friday from 8:30 am to 6:00 pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Cabeca, can be reached on (703) 308-3116. The fax number for this group is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3800.


CAO (KEVIN) NGUYEN
PRIMARY EXAMINER
December 11, 2003

